

NOV 09 2005

Appl. No. 10/661,735
Amdt. Date Nov. 9, 2005
Reply to the Advisory Action of Oct. 4, 2005

REMARK

Applicants really appreciate Examiner for the arduous work to examine the instant application.

Applicants have canceled claims 1-8, 10 and 12-16, and have amended claim 9 to include the subject matter of claim 10, and claim 11 to include the limitation of claim 12 reciting "from a micro-viewpoint". No new search or consideration is required under these amendments.

Applicant has deleted the improper word "relatively" cited in paragraph 4 which mistakenly results in an admission type rejection.

Rejections under Robertson and Dougherty in the prior Office Actions

In the prior Office Actions, specially the first Office Action, Applicants submit that the rejection to the claims 9-12 is improper and should be withdraw, for the reasons below as previously misunderstood by Examiner:

In the first Office Action for claim rejections under 35 USC §103(a):

I) Examiner rejected claims 1-11 as being unpatentable over the admission in view of Robertson (Pat. No. 3,195,770);

Examiner pointed out that Admission fails to disclose the hard trays bottom portion has a smooth planar surface. Examiner stated that Dictionary.com defines rough as 1. "having a surface marked by irregularities, protuberances, or ridges; not smooth". In keeping with this interpretation, Examiner provided Robertson as a teaching for a tray having individual members 10 appear to be protuberances. Then, Examiner stated that it would have been obvious to combination Admission with Robertson to have the feature "bottom surface of the bottom portion not smoothly planar" to prevent sticking.

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II) Examiner rejected claims 1-12 as being unpatentable over the admission in view of Dougherty (Pat. No. 2,588,812);

Examiner pointed out that Admission fails to disclose the hard trays bottom portion has a smooth planar surface. Examiner stated that Dictionary.com defines rough as 1. "having a surface marked by irregularities, protuberances, or ridges; not smooth". In keeping with this interpretation, Examiner provided Dougherty as a teaching for two reasons: One is that Dougherty is analogous art in solving a same problem where flat surface have a tendency of sticking together. The other is Dougherty also provided surface irregularities, such as ridges 12. Then, Examiner stated that it would have been obvious to combination Admission with Dougherty to have the feature "bottom surface of the bottom portion not smoothly planar" to prevent sticking.

In response, Applicants do not deny Examiner's interpretation of "rough" according to Dictionary.com while believe Examiner mistreated either "the bottom surface---not smoothly planar---with a plurality of tiny protrusions to be in a rough form" (Emphasis added, recited in amended claim 9, hereinafter referred to "first limitation") or "bottom surface---not smoothly planar---with either recesses or openings therein from a micro-viewpoint" (Emphasis added, recited in amended claim 11, hereinafter referred to "second limitation") with the single term of "rough" defined by Dictionary.com.

In brief, in the first action this typo, i.e., the word "the bottom surface---not smoothly planar" mistakenly replaced with the word "rough", led Applicants to make such an argument. Anyhow, Applicants like to point out either first limitation or second limitation clearly represents that 1) a bottom surface not smoothly planar but with a plurality of tiny protrusions or recesses or openings, from a micro-viewpoint, to be in a rough form is the surface wholly has a rough plane to the touch of observer, but still flat plane to the sight.

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which is essentially different from the single term "rough" defined as both to the touch and sight of observer by Dictionary.com, and not essentially equal to those identified by Examiner; 2) the bottom surface has designed the whole surface to be not smoothly planar, **NOT** a selected portion, for example, along a side, or at one end.

Based upon the clarification above, Applicants like to reargue for Point I) and II) regarding the pending claims 9, 11 and 13-16 due to claims 1-8, 10 and 12 having been canceled.

Regarding Point I), At first, Robertson should not be regarded as analogous art with electrical connector field of the instant application, in that *Robertson* provides concave surfaces, **NOT** flat surfaces as defined by the instant application, which is further implied by Examiner in *Dougherty*. (See *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993))

Secondly, Examiner failed to assert a *prima facie* case of obviousness. One element of a *prima facie* case requires a motivation to combine or modify the references to have made the claimed invention.

The mere fact that the references could be combined does not render the combination obvious. A motivation must exist that suggests the desirability of the combination to have the claimed invention. In fact, Robertson discusses an offset provided extending across the **end** 20 of the upper member 10 and along the **sides** 26 and 28. Combining Admission with *Robertson* would render the combined invention unsatisfactory for the instant application's stated purpose, i.e. for preventing sticking between **two flat surfaces**, even if Admission can be qualified to combine with *Robertson*. Specifically, even if the offset in *Robertson* is applied to Admission by extending across the **end** of the bottom flat surface and along the **sides**, sticking of the two flat surfaces

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of the pick up cap top surface and the tray bottom surface is still not prevented, because such an offset merely acts on the periphery portions thereof other than the central flat surfaces, thereby providing none of the benefit of preventing sticking between the two flat central surface. Therefore, no proper motivation exists for combining *Robertson* with Admission to have the claimed invention in amended claims 9 and 11, even if *Robertson* can be qualified to combine with Admission.

Regarding Point II), Examiner still failed to assert a *prima facie* case of obviousness. One element of a *prima facie* case requires a motivation to combine or modify the references to have made the claimed invention.

The mere fact that the references could be combined or modified does not render the combination or modification obvious. A motivation must exist that suggests the desirability of the modification or combination. In fact, *Dougherty* discusses parallel, uniformly shaped and dimensioned ridges 12, preferably of triangular cross-section, are fashioned on upper surfaces of the respective cakes, for not only preventing adhesion therebetween (col.3, lines 32-34) but also affording a complete support to keep the cakes from sagging (col.3, lines 18-19). If these ridges 12 in *Dougherty* can be modified to be "a bottom surface—not smoothly planar—but with a plurality of protrusions or recesses, from a micro-viewpoint" recited in amended claim 9 and 11, *Dougherty* provides no such benefit of "affording a complete support to keep the cakes from sagging". Therefore, no proper motivation exists for modifying *Dougherty* to combine with Admission to have the claimed invention in amended claims 9 and 11, even if *Dougherty* can be qualified to combine with Admission.

From the reasons above, the amended claims 9 and 11 are believed to patentably distinguish over *Robertson* or *Dougherty*, alone or combining with the other cited references, and in condition for

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allowance. Claims 13-16 are also allowable by reason of at least its dependency upon claim 11. Accordingly, Applicants request that Examiner reconsider and withdraw the rejections thereto.

Rejections under 35 U.S.C. 112 in the prior Office Actions and the Advisory Action

Anyhow, Applicants have viewpoint different from Examiner's statements in the prior Office Actions and the Advisory Action:

I) Examiner stated the instant application must include a claim particularly point out and distinctly claim the subject matter which applicant regards as his or her invention.

II) Examiner stated the specification is defective and does not provide even one working embodiment.

In response, regarding the point I) above, as discussed in the previous paragraphs, the instant application is believed to patentably distinguish over the references, and therefore includes at least one pending claim particularly pointing out and distinctly claiming the subject matter, which applicants regard as their invention.

Regarding the point II), the specification need not describe or enable the invention to a layperson. Rather, it need only describe the invention to one of ordinary skill in the art. In deed, the specification need not contain a working example if the invention is otherwise disclosed in such manner that one skilled in the art would be able to practice it without undue experimentation. (See *Cedarapids, Inc. v. Nordberg, Inc.*) According to the Federal Circuit, "Patents are not production documents... Thus the law has never required that a patentee who elects to manufacture its claimed invention must disclose in its patent the dimensions, tolerances, drawings, and other parameters of mass production not necessary to enable one skilled in the art to practice

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(as distinguished from mass-produce) the invention. Therefore, Applicants respectfully request that Examiner reconsider and withdraw the rejection thereto.

In brief, the reader of the specification and the claims can easily know what a plane the applicant tries to claim and such a plane should not be like the references cited by the Examiner. As to the rejection under 35 U.S.C. 112, the second paragraph, Applicant believes the term "rough surface" or "surface rough enough" is acceptable to the PTO according to attachment (I) showing there are 1176 patents using the term "rough surface" and there are at least two patents using the term "surface rough enough". It is NOT an indefinite term.

As to the rejection under 35 U.S.C. 112, the first paragraph, associated with an assertion by the Examiner that there are undue experiments required, Applicant points out that changing the smoother surface to the rough surface is a simple process without requiring detailing the roughness involved therewith. As mentioned in an earlier time, *a roughness-felt flat surface is simply the invention*. The Examiner complicates the case here. The Examiner raises the questions regarding how many trays are stacked on top one another, how long trays can be stacked, how much time the surfaces have taken to "seat" or whether the parameter is dependent on how fast one tray is removed from another. In fact, only the top tray and the one right below it are concerned about and involved therewith at the operation moment, disregarding how many trays are stacked or how long the trays can be stacked. The value of the invention is not to find out how precise roughness the surface should have but roughen the surface for avoiding sticking. Because the roughening of the surface is an easy stuff for the skilled person, there should be no undue experiments involved/required.

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Conclusion

In view of the above claim amendments and remarks, the subject application is believed to be in a condition for allowance and an action to such effect is earnestly solicited.

Respectfully submitted,

ZHANG ET AL.

By 
Wei Te Chung

Registration No.: 43,325

Foxconn International, Inc.

P. O. Address: 1650 Memorex Drive,
Santa Clara, CA 95050

Tel No.: (408) 919-6137

Patent Database Search Results: ACLM/"rough surface" in 1976 to present

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Results of Search in 1976 to present db for:
ACLM/"rough surface": 1176 patents.
Hits 1 through 50 out of 1176

Attachmat (I)

Next 50 Hits

Jump To

Refine Search

ACLM/"rough surface"

PAT.
NO.

Title

- 1 6,958,202 **T** Donor element for adjusting the focus of an imaging laser
- 2 6,956,209 **T** Sample plate for matrix-assisted laser desorption and ionization mass spectrometry
- 3 6,956,167 **T** Lid-holding frame used in production of hollow-package type electronic products, and sealing-process using such lid-holding frame
- 4 6,953,284 **T** Dustproof structure for a sleeve bearing
- 5 6,953,254 **T** Silicon wafer based macroscopic mirror for wide angle scanning applications
- 6 6,950,234 **T** Protective film for a prism lens
- 7 6,948,357 **T** Cam shaft intake angle examining device
- 8 6,947,103 **T** Method of making a reflection type liquid crystal display device
- 9 6,945,364 **T** Elevator roller guide and rail assembly
- 10 6,943,948 **T** Fresnel lens sheet and transmission type projection screen
- 11 6,941,657 **T** Nail clippers
- 12 6,936,086 **T** High conductivity particle filter
- 13 6,935,353 **T** Mobile rehabilitative walker
- 14 6,933,494 **T** Optical sensor heads exhibiting regularity in optical characteristics and optical sensor system using the same
- 15 6,928,033 **T** Magneto-optical recording medium having a plurality of heat-radiation films
- 16 6,927,343 **T** Contactor for testing miniaturized devices and components
- 17 6,926,789 **T** Wiring transfer sheet and method for producing the same, and wiring board and method for producing the same
- 18 6,921,857 **T** Color filter board and manufacturing method thereof, liquid crystal display panel, and electronic equipment

Patent Database Search Results: ACLM/"surface rough enough" in 1976 to present

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Results of Search in 1976 to present db for:

ACLM/"surface rough enough": 2 patents.

Hits 1 through 2 out of 2

Altaheart (I)

Jump To

Refine Search

ACLM/"surface rough enough"

PAT. NO. Title

1 4,187,274 **T** Method for forming sheets having reduced surface imperfections2 3,949,130 **T** Spun bonded fabric, and articles made therefrom[Top](#)[View Cart](#)[Home](#)[Quick](#)[Advanced](#)[Pat Num](#)[Help](#)